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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,760	12/31/2003	Donald Aldridge	520219-299	9118
27805	7590	11/09/2007		
THOMPSON HINE L.L.P. Intellectual Property Group P.O. BOX 8801 DAYTON, OH 45401-8801			EXAMINER HANAY, RICHAE LEE	
			ART UNIT 3765	PAPER NUMBER
			MAIL DATE 11/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/749,760

Applicant(s)

ALDRIDGE ET AL.

Examiner

Richale L. Haney

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1- 10, 12 - 36 and 39-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13 and 32 is/are allowed.
- 6) ☒ Claim(s) 1- 10, 12, 14 - 31, 35, 36 and 39-61 is/are rejected.
- 7) ☒ Claim(s) 33 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment filed on 11/3/2006 has been considered. Claims 1, 7, 8, 9, 13, 23, 26, 30, 32, 35, 40, 45, and 49 were amended. Claims 50 – 61 were added. Claims 11 and 37 – 38 were cancelled. Claims 1- 10, 12 – 36 and 39-61 are currently pending.

Claim Objections

1. Claim 3 is objected to because of the following informalities: The status indicator of claim 3 indicates that the claim has been amended. However, the claim was not amended. Appropriate correction is required.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 7 and 8 recite a closed loop and closed loop tubular shape. There is not antecedent for the claimed terminology in the originally filed disclosure.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the inner surface of the

Art Unit: 3765

pouch is located outside the outer surface of the pouch must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

Art Unit: 3765

applicant regards as the invention. Applicant recites that the pouch has an inner and outer surface and when in an inverted configuration the inner surface is located outside of the outer surface. It is unclear how the inner surface is capable of being located outside of the outer surface of the pouch.

6. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant recites a pouch defining a generally closed shape having an inner volume and the pouch generally located inside the inner volume and a pouch located outside of the inner volume. It is unclear how a pouch can be defined by an inner volume and also is located on both inside and outside of an inner volume.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 – 3, 5, 7 – 8, 10, 12, 14, 15, 39, 40, 42, 50, and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Bailey (US 2,292,347). The device of Bailey discloses an outer shell (Figure 1) shaped to fit about the arms, chest, torso and legs of the wearer, the outer shell (10) is a single integral piece of material, a pouch coupled (11) to the interior of the outer shell, being sized and shaped to receive and retain generally all of the outer shell therein when the outer shell is in a compact position

Art Unit: 3765

(Figure 3), the pouch includes an upper mouth (15) and a lower mouth (14) located generally opposite side of the pouch relative to the upper mouth (Figure 1), wherein upper (17) and lower (16) fastening mechanisms for selectively opening and closing the upper and lower mouths. It is noted that when the upper and lower mouths are closed an inner volume is inherent and would form a closed loop shape on both the inner and outer surfaces and the upper and lower mouth are in communication with each other via an inner volume. The pouch is moveable between an inverted internal position wherein the pouch is located inside the outer shell (Figure 1) and an external position wherein the pouch is generally located outside the outer shell (Figure 3). It is noted that inverted is defined by Merriam-Webster dictionary as "to reverse in position, order, or relationship," the relationship of the upper and lower mouths of Bailey is reversed. The pouch is secured to the outer shell, in a position that is accessible to the wearer, and is secured generally around the entire periphery of the upper mouth (22, 23) and the pouch is configured as a sleeve when the upper and lower mouth are open. Sleeve is defined by Merriam Webster dictionary as "an open ended, flat cover" and is met by the pouch structure of Bailey. It is known that any and all fabric or material of a jacket would provide some degree of protection against abrasion, flame and heat. The USPTO office does not a laboratory to perform testing and cannot therefor ascertain the level of protection that Bailey would provide, since the device of Bailey performs in the same manner as the claimed invention, having a protective shell, it can be assumed that resistance of the fabric would be of a similar configuration. The applicant does not claim

specific types of fabrics that have these characteristics and therefore the prior art referenced meets the cited limitations.

9. Claims 49, 60 and 61 are rejected under 35 U.S.C. 102(b) as being anticipated by Itoi (US 4,476,587). The device of Itoi discloses an outer shell (3, 20) shaped to fit about at least a part of the body of a wear the outer shell being foldable into a compact position and wherein said outer shell can resist igniting, burning, melting, dripping or separation. A pouch (2) coupled to the outer shell, the pouch being shaped and sized to receive generally all of the outer shell therein when the outer shell is in a compact position (Figure 5). The pouch including an upper mouth (12, 14) and a lower mouth (19) located on generally opposite sides wherein the upper mouth and lower mouth are both selectively and independently openable and closable (12, 14, 15, 16). The pouch defines a generally closed shaped having an inner volume (Figure 5). It is known that any and all fabric or material of a jacket would provide some degree of protection against abrasion, flame and heat. The USPTO office does not a laboratory to perform testing and cannot therefor ascertain the level of protection that Bailey would provide, since the device of Bailey performs in the same manner as the claimed invention, having a protective shell it can be assumed that resistance of the fabric would be of a similar configuration. The applicant does not claim specific types of fabrics that have these characteristics and therefore the prior art referenced meets the cited limitations.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey in view of Itoi (US 4,502,155). The device of Bailey is lacking hook and loop tape as a fastening material. The device of Itoi discloses a pouch having hook and loop (18A, 19A) material as closures at the bottom of the pouch (6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bailey by utilizing hook and loop tape instead of zippers since they are known functional equivalents in the art.

12. Claims 16 – 23, 43, 44, 54, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey in view of Hayes (US 6,341,384). The device of Bailey is lacking an outer shell comprising an aramid material, a thermal liner and a moisture barrier consisting of expanded polytetrafluoroethylene (PTFE). The device of Hayes discloses an outer shell of a garment comprising aramid materials (30), a moisture barrier located generally inside and coextensive with the outer shell (40), and a thermal liner located generally inside the outer shell so that the moisture barrier (50) is in between the thermal liner and the outer shell. The moisture barrier (40) is comprised of GORE TEX® a type of expanded PTFE and the thermal liner (50) is comprised of an aramid batting (Column 1, lines 63 – 67). It would have been obvious to one of ordinary

Art Unit: 3765

skill in the art at the time the invention was made to modify the device of Bailey by incorporating an aramid material, moisture barrier and thermal liner in order to protect the wearer from heat (column 1, lines 10 – 25).

13. Claims 9, 41 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey in view of Itoi (US 4,476,587). The device of Bailey substantially discloses the claimed invention but is lacking a pouch on the front of the garment. The device of Itoi discloses a pouch on the front (18) of the garment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the placement of pocket to the front where it may be more easily accessed. It is noted by the examiner that Bailey states that the locality of the pouch may be modified to other areas of the garment (Column 3, lines 31 – 34). The device of Bailey substantially discloses the claimed invention but is lacking a generally tubular sleeve when the upper and lower mouths are entirely open. The device of Itoi discloses a convertible garment having a pouch (2) forming a generally tubular sleeve wherein the upper mouth (12, 14) and the lower mouth (19) are both selectively and independently openable and closable. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device of Bailey by utilizing the pouch of Itoi in order to provide storage means for the garment and easily carrying the pouch by fastening mechanisms (15 and 16).

14. Claims 24, 25, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey and Hayes as applied to claims 16 – 23, 43, 44, 54, and 57 above, and further in view of Itoi (US 4,476,587). The modified device of Bailey

Art Unit: 3765

substantially discloses the claimed invention but is lacking a generally tubular sleeve when the upper and lower mouths are entirely open. The device of Itoi discloses a convertible garment having a pouch (2) forming a generally tubular sleeve wherein the upper mouth (12, 14) and the lower mouth (19) are both selectively and independently openable and closable by independent fastening mechanism (12, 14, 15, 16). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to further modify the device of Bailey by utilizing the pouch of Itoi in order to provide storage means for the garment and easily carrying the pouch by fastening mechanisms (15 and 16).

15. Claims 26 – 31, 35, 36, 45, 47, 48 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey in view of Greenberger et al (US 4,689,831). The device of Bailey substantially discloses the claimed invention but is lacking pant legs. The device of Greenberger et al. shows a convertible garment being stored in a pouch (36) having pant legs (Figure 7, 34). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device of Bailey by utilizing the pant legs of Greenberg et al. in order to provide an convertible garment for sleeping in outside conditions (column 3, lines 30 – 35).

In regard to method claims 26 – 31, 35, 36, 45, 47 and 48 it is the position of the examiner that when the structural limitations of the claimed device are present the device is inherently capable of performing in the same manner claimed by the applicant. The modified device of Bailey is capable of storing the garment in the method claimed by applicant.

Art Unit: 3765

16. Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey and Hayes as applied to claims 16 – 23, 43, 44, 54, and 57 above, and further in view of Greenberger et al (US 4,689,831). The device of Bailey substantially discloses the claimed invention but is lacking pant legs. The device of Greenberger et al. shows a convertible garment being stored in a pouch (36) having pant legs (Figure 7, 34). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to further modify the device of Bailey by utilizing the pant legs of Greenberg et al. in order to provide an convertible garment for sleeping in outside conditions (column 3, lines 30 – 35).

17. Claims 46, 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey in view of Greenberger et al. as applied to claims 26 – 31, 35, 36, 45, 47, 48 and 51 above, and further in view of Itoi (Us 4,476,587). The device of Bailey substantially discloses the claimed invention but is lacking a pouch on the front of the garment. The device of Itoi discloses a pouch on the front (18) of the garment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the placement of pocket to the front where it may be more easily accessed. It is noted by the examiner that Bailey states that the locality of the pouch may be modified to other areas of the garment (Column 3, lines 31 – 34). The device of Bailey substantially discloses the claimed invention but is lacking a generally tubular sleeve when the upper and lower mouths are entirely open. The device of Itoi discloses a convertible garment having a pouch (2) forming a generally tubular sleeve wherein the upper mouth (12, 14) and the lower mouth (19) are both selectively and independently

Art Unit: 3765

openable and closable. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device of Bailey by utilizing the pouch of Itoi in order to provide storage means for the garment and easily carrying the pouch by fastening mechanisms (15 and 16).

Allowable Subject Matter

18. Claim 13 and 32 are allowed.
19. Claims 33 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

20. Applicant's arguments filed 11/30/2006 have been fully considered but they are not persuasive.
21. Applicant submits that the flat panel of Bailey does not form a pouch. The device of Bailey discloses a panel having an upper and lower mouth for fastening together to form a pouch for storing the garment. The device of Bailey meets the claim limitations claimed by applicant when interpreted in the broadest reasonable sense. Applicant further argues that the device of Bailey is not foldable into a compact position for storing within the pouch. Applicant is pointed to Figure 3 of Bailey, where the garment is clearly shown folded in a compact position and stored within the pouch (11). Applicant submits that the upper and lower mouths of Bailey are not located on opposite sides of the

Art Unit: 3765

pouch. It is pointed out that the upper and lower mouths of Bailey are located on opposite sides of the pouch when in an open position. The device of Bailey meets the limitations as claimed by the applicant when interpreted in the broadest possible sense. Applicant argues that the device of Bailey does not fit "about the legs of the wearer." The device of Bailey is formed to fit about at least a portion of the legs of the wearer, since the bottom edge of the garment would lie around the wearer's legs. It is pointed out the position of the garment on the wearer would be dependent on the size of the wearer and this recitation does not provide a structural limitation in the claim.

22. In response to applicant's arguments that the upper mouth of Bailey is not secured directly to the outer shell along its perimeter, it is pointed out that the claim requires that the pouch be coupled to the outer shell "generally around the entire perimeter of the mouth." When interpreted in the broadest reasonable sense, the stitching of Bailey at 15 is generally around the entire periphery of the mouth.

23. Applicant submits that the device of Bailey does not disclose an upper and lower mouth and therefor do not communicate via an inner volume. It is the position of the examiner that the device of Bailey discloses an inner volume formed by upper and lower mouths and is therefore in communication via an inner volume.

24. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

Art Unit: 3765

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one would be motivated to move the position of the pouch to the front panel of the garment as disclosed by Itoi in order to provide easy access to the pouch for the wearer.

25. Applicant submits that the mouths do not form a "closed loop" shape. It is the position of the examiner that the device of Bailey defines a pouch having a closed loop shape as claimed with the mouths are in a secured position. In regard to claim 53, the pouch is generally tubular in a closed position and the mouths are generally located on opposite sides when in a first open position. The device of Bailey meets the limitation as recited by applicant when interpreted in the broadest reasonable sense.

26. Applicant's arguments with respect to claims 9, 26, 49, 51, 52, have been considered but are moot in view of the new ground(s) of rejection.

In regard to applicant's arguments that Bailey does not disclose an outer shell having heat resistance up to 500°F, it is the position of the examiner that the device of Bailey or Itoi meets these limitations since both are made of a material that would provide some degree of protection against heat. Any equivalent piece of prior art having the same structure as that claimed by applicant would anticipate the limitation as claimed since the structure would be expected to perform in the same way since all of the structural elements are present. The limitation directed to resisting igniting, burning, melting or dripping at 500°F is a functional recitation. It is noted that applicant has not claimed specific fiber or fabric types having the claimed properties.

Conclusion

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richale L. Haney whose telephone number is 571-272-8689. The examiner can normally be reached on M-F 8:00 - 4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on 571-272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3765

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Richale L Haney
Examiner
Art Unit 3765

RLH
10/30/2007


KATHERINE MORAN
PRIMARY EXAMINER